

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-12 are pending in the application, with 1 and 6 being the independent claims. Applicants seek to amend claims 1, 2, and 5-10. New claims 11 and 12 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Claim Objections

Claims 7-10 stand objected because they depend on apparatus claim 6 rather than independent method claim 1 as previously presented. The suggested amendments have been made. Therefore, claims 7-10 are now allowable.

Rejections Under 35 U.S.C. § 103

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dierke (US 5,920,833) in view of Fushiki et al. (US 5,200,750) and Hamasaki et al. (US 5,682,162). Reconsideration of claims 1-10 is respectfully requested.

To establish a prima facie case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, MPEP Section 2142.

Applicants respectfully submit that the combined teachings of Dierke, Fushiki, and Hamasaki fail to teach or suggest the claimed invention. In particular, the combination of references fails to teach or suggest a method or apparatus that, *inter alia*, mutes a PCM input to the mapper when a predetermined number of consecutive zero level PCM samples have been sensed, as recited in claim 1. Similar features are recited in claim 6.

The Office Action indicates on page 3, lines 9-11 that Applicants' claimed feature of muting a PCM input to the mapper when a predetermined number of zero level PCM samples have been sensed is taught in Hamasaki, column 12, lines 42-45. Applicants respectfully contend that the disclosed method and apparatus is unobvious in view of Hamasaki under MPEP 2144.04(II)(B) (stating that omission of an element and retention of the element's function is indicia of unobviousness).

In an embodiment of the instant invention, the mute function is activated when the apparatus senses a predetermined number of consecutive zeros (paragraph 0076). Although the invention disclosed in Hamasaki also performs the same function, it requires the presence of two parameters (column 7, lines 15-22). Specifically, Hamasaki requires 1) a string of consecutive zeros either equal to or greater in duration than a first period and 2) the presence of an output reference level code detection signal (column 7, lines 15-22). The presence of this additional second parameter does not enhance the mute function. Rather, the second element merely "pass[es] the modulated output ... without any alteration" (i.e., provides no functional enhancement) (column 6, lines 64-67) or commands the system to activate the mute function (i.e., performs what the instant invention does) (column 6, lines 64-67). Because an embodiment of the instant

invention accomplishes the same function without the second parameter, it is unobvious in view of Hamasaki under MPEP 2144.04(II)(B).

In addition to being unobvious under MPEP 2144.04(II)(B), the claimed feature is also unobvious in view of Hamasaki because Hamasaki utilizes a different mute activation mechanism. In an embodiment of the instant invention, the system activates the mute function after sensing a predetermined number of zero level data (paragraph 0076). In Hamasaki, muting occurs after sensing zero level data for a "continuous period of time equal to or longer than a first period" (column 15, lines 30-34). Whereas an embodiment of the instant invention activates the mute function based on the number of zeros, Hamasaki activates the mute function based on a specified period of time.

Although one may calculate the number of zeros in the "first period of time" by dividing the duration of the period by the duration of a single data pulse, mathematical manipulation will not defeat this argument. Because the duration of the period in Hamasaki is based on the clock used (column 9, lines 41-43), neither the period nor the corresponding number of zeros can be modified without changing the clock. This consequence is in direct contrast to an embodiment of the instant invention where the predetermined number of zeros is programmable (paragraph 0076) and, thus, can be varied without changing the clock.

The Office Action further states on page 4, paragraph 2 that the instant invention is obvious in view of Fushiki because Fushiki cites a "zero counter [that] counts up a predetermined number" (column 7, line 68 to column 8, line 1) of zeros and that "the predetermined number [of zeros] is programmable" (Office Action, page 4, paragraph 2). Applicants respectfully contend that the zero counter in Fushiki is not programmable. A

zero counter that features a predetermined threshold does not automatically qualify it as programmable.

Rather, there is an inherent difference between a predetermined feature and a programmable feature. Whereas the former (predetermined) implies a constant value, the plain meaning of the latter (programmable) suggests a value that can be changed even after a system has been initialized. Although Fushiki does disclose the use of a predetermined threshold, the application never explicitly claims this feature. However, where the specification describes this feature, it is only in reference to a predetermined number with no suggestion of being modifiable (column 6, lines 48-56; column 7, line 64 to column 8, line 2). This is in direct contrast to the instant invention where the language discloses a predetermined value that is programmable (paragraph 0076; claim 4).

Therefore, assuming *arguendo*, that one would be motivated to combine these references in the manner suggested by the Office Action, the present invention would not be obvious in view of such combinations. The suggested combinations would not result in the presently claimed invention.

In view of the above arguments, it is clear that the present invention would not have been rendered obvious by the suggested combinations to one of ordinary skill in the art at the time of the invention. Therefore, claims 1 and 6 are allowable under 35 U.S.C. § 103 as being patentable, either alone or in combination, over Dierke, Fushiki, and Hamasaki.

Claims 2-5 and 7-10 depend from claims 1 and 6 respectively, and are therefore now allowable at least for the reasons claims 1 and 6 are allowable, and for the specific features recited therein.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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